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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/980,620 11/23/92 LEWAK

PD-1253

EXAMINER

ESM1/0803

SPENSLEY, HORN, JUBAS & LUBITZ
1880 CENTURY PARK EAST
FIFTH FLOOR
LOS ANGELES, CA 90067

ART UNIT

PAPER NUMBER

2307

DATE MAILED: 08/03/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5/13/94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s) 0 day(s) from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1 to 27 and 30 to 31 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 28 and 29 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1 to 27 and 30 to 31 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☒ Other SEE ATTACHED

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Part III DETAILED ACTION

15. Claims 1-27 and 30-31 are presented for examination.

16. Applicants title has been considered and the examiner will provide a suitable title at such time as the application becomes otherwise acceptable for allowance.

Response to Amendment

17. The amendment filed May 13, 1994 is objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of the word pre-defined in claims 1-4 and 21-24 thus apparently claiming the list of categories is developed from predefined categories descriptions. The examiner can find^{no} indication in the specification as originally filed or the original claims that the list of categories is defined from pre-defined category description.

Applicant is required to cancel the new matter in the response to this Office action.

18. Claims 1-6 and 21-26 are objected to under Title 37 § 1.75 (d) (1) which states:

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The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a))

the addition of the word pre-defined in claims 1-4 and 21-24 to apparently claim that the list of categories is developed from predefined categories. The examiner can find no indication in the specification that the list of categories is defined from pre-defined category description thus the listed claims do not conform to the invention as set forth.

19. Applicant's arguments filed May 13, 1994 have been fully considered but they are not deemed to be persuasive except as specifically noted in the following paragraphs in which case the arguments are deemed to be moot in view of the new grounds of rejection.

Response to Arguments

20. Response to applicants arguments referent to 35 USC § 102 Claim Rejections. The text of the appropriate sections of Title 35, U.S. Code and text of the rejections and references

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used for rejection not included in this action can be found in a prior Office Action.

21. As to claim 1, the applicant argues that (1) the attributes of Schwartz et al., patent no. 5,047,918 allows the user to assign any name he chooses to an attribute while the system of the present invention restricts the choice of attributes to a predefined list. The applicant further asserts (2) that the user cannot select a value/category at will in the present invention.

22. The examiner respectfully disagrees with applicants interpretation of both Schwartz and the invention. (1) Schwartz when he states the user "is not limited to selecting from among a fixed number of predefined attributes" (col. 4, line 39-43) he is referring to systems that were hardwired and had a specific number of attributes that could not be changed at all short of changing hardware. Also in Schwartz the list is built as the user assigns character strings and while he may add new attributes or categories at will he may also choose from the existing list. It is pointed out that in the claim no reference is made to the form of the list or the method of selection. The fact that it discloses additional structure not claimed, by also allowing selection of attributes not on the list, is irrelevant. (2) The specification states that the user may "edit such

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categories as they are used" (page 7, line 6) specifically while the files are being assigned categories (starting on page 15) the Categories Window is displayed the "category types may be added or deleted" (page 16 line 27) and "category descriptions may be edited or deleted, and new category descriptions may be added" (page 17 line 1). It is apparent in the preferred embodiment of the invention that if the category is not on the list when categorizing a file the user may simply add it as under Schwartz's system one could add a user defined character string.

23. As to the rejection of claims 2 and 3 the applicant argues that (1) the system described by Cochran et al., in patent no. 5,206,949 does not relate to files in a data storage system; (2) does not have a single file of records pertaining to the files; and (3) does not disable the displayed items in a list; and (4) searches of entries are required.

24. The Examiner respectfully disagrees. (1) The system of Cochran refers to data set or selectable data entity (col.4 line 45). The data set in the set based data systems is equivalent to a file in relational data systems and a data base is a data storage system. (2) The limitations in the body of the claim are not functionally related to the limitations as set forth in the preamble. Specifically as claimed, none of the

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steps in the body of the claim depend on their being a single record file as any method of indexing the files would work. Implicitly for searching the data sets in Cochran's system there would be some system of indexing whether gathered in one file or distributed through the system. (3) Cochran's invention includes a variation of the invention in which the lists are dynamic. The dynamic lists of valid categories change the categories displayed are reduced (this is implicit as Cochran's invention displayed choices to select for search filter). When a category description is no longer displayed it is effectively disabled from being selected. (4) Applicant misinterprets the principle that claims are interpreted in the light of the specification. Although the method of determining which category descriptions are still valid is found as examples or embodiments in the specification, this method was not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims.

25. As to claim 4, the examiner agrees that the system taught by Schwartz does not include selecting from the displayed list of categories. Accordingly a new rejection is provided after the rebuttal of the arguments below.

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26. As to the rejection of claim 27, Applicant claims that there is no "category linking" provided. The examiner respectfully disagrees. The tabs as described in the **Thought Pattern Handbook** are the categories and they can be "linked" to *tab groups* which are the "linking categories" (page 4, lines 23-30 {paragraph 4}). For any files to be linked to a group the file must be linked to one of the tabs in that group. (See also page 12 and page 17 for further detail.)

27. Response to applicants arguments referent to 35 USC § 103
Claim Rejections.

28. As to claims 5, and 6 see the rebuttal to arguments in paragraphs above.

29. As to claim 7, in response to Applicant's piecemeal analysis of the references, one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In reference to the table the examiner took official notice that this was well known in the art in the last action in fact Cochran does reinforce this (figures 1a and 1b). The file information directory not in Cochran was described in Schwartz as referenced and the last

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office action. And the creation of the search filter is from Cochran as argued in the paragraphs included hereinabove. Also proper grounds for combination where given in the last office action.

Claim Rejection - 35 USC § 103

30. Claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over Schwartz et al., patent no. 5,047,918 in view of Bananafish Software, Inc., in the Thought Pattern Handbook.

31. Schwartz disclosed an invention substantially as claimed including a DP system comprising the steps of "defining" (col. 4, lines 26-43); "accepting" (col. 4, lines 12-25); and "storing" (col. 11, lines 55-59; col. 12, lines 10-12 and 29-38) Note it is implicit that the "node record" or file record of Schwartz et al would be labeled with a file name for identification of the record); "displaying" (col. 23, lines 26-68); and "accepting" (col. 9, lines 62-67); "searching" (col. 9, lines 12-17); and "displaying the file name" (col. 10, lines 1-5). It is implicit to returning the files that they may be displayed.

32. Schwartz does not detail selecting the categories for the search filter from a displayed list. Bananafish describes a

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system which includes selecting from a displayed list (page 23 lines 3-7).

33. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Schwartz and Bananafish because selecting from a displayed list is quicker and eliminates the possibilities of errors that exist when typing in a search filter improving the versatility of the DP system.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Belove et al.	5,115,504	Categories and linking
van Kir		<i>Lotus, Traveling Software tackle DOS management problems.</i>

35. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION

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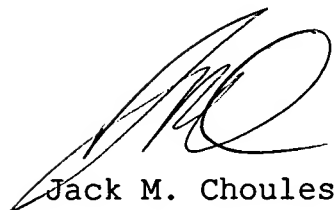
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IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Choules whose telephone number is (703) 305-9840. The examiner can normally be reached on Tuesday-Friday from 7:15 AM - 4:45 PM and generally on Tuesdays and Thursdays until 6:45. The examiner can also be reached on alternate Mondays.

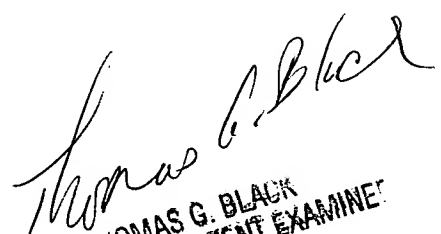
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached at (703)-305-9707. The fax phone number for this Group is (703)-305-9564 or 9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.



Jack M. Choules

July 28, 1994



THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 2300